

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 9, 20, and 21 have been amended, and claims 2 and 10 have been canceled. Thus, claims 1, 3-9, and 11-23 are currently pending in the application and subject to examination.

I. Nakano

Claims 1-17 and 20-23 are rejected under 35 U.S.C. § 102(a) as being anticipated by JP 11-25930 to Nakano Toshiaki ("Nakano"). Claims 18-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of U.S. Patent No. 6,233,506 to Obradovich ("Obradovich"). It is noted that claims 1, 9, 20, and 21 have been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

A. Claims 1, 3-5, 7-9, 11-13, 15-16, and 18-19

Amended claims 1 and 9 recite in part an e-mail sending and receiving system where each e-mail is written on a web page provided by a communications center, the system comprising a positional data storage section, wherein the positional data storage section includes a plurality of physical positional data registered by an addresser.

This allows a user to store and later browse positional data they previously selected and registered themselves.

Nakano teaches a user accessing a map database center on the internet and sending a message to a recipient. However, Nakano does not disclose or suggest that

a positional data storage section includes a plurality of physical positional data registered by an addresser.

The Office Action indicated that this feature is taught in paragraphs 22-24 of Nakano. However, this section of Nakano merely states that the map database center includes a landmark database. Nakano does not disclose or suggest that these landmarks are registered by an addresser, or User A.

For at least this reason, the Applicants submit that claims 1 and 9, as amended, are allowable over the cited prior art. As claims 1 and 9 are allowable, the Applicants submit that claims 3-5, 7-8, 11-13, 15-16, and 17-19, which depend from allowable claims 1 and 9, are therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

ii. Claims 6 and 14

Claims 6 and 14 recite in part an e-mail sending and receiving system for sending and receiving e-mail between communication terminals, including a positional data attaching section for attaching one or more of a physical positional data stored in a positional data storage section to the e-mail message generated by the mail generating section, and a detailed data generating section for generating detailed data relating to each physical positional data attached to the e-mail message, and attaching a URL for accessing the detailed data to the e-mail message.

Nakano teaches sending a message to a recipient, User B, having map image data. However, Nakano does not disclose or suggest attaching a URL for accessing detailed data relating to each physical positional data to an e-mail message.

The Office Action cites paragraphs 16 and 27-29 of Nakano. However, these paragraphs merely state that the addresser, User A, enters a URL into their internet browser in order to first access a map information website. Nakano does not disclose or suggest a URL being attached to an e-mail message being sent to an addressee, User B, as recited in claims 6 and 14.

For at least this reason, the Applicants submit that claims 6 and 14 are allowable over the cited art.

C. Claims 20 and 21

Amended claims 20 and 21 recite in part an e-mail sending and receiving system including a mail generating section, for generating an e-mail message to be sent to an addressee, wherein the mail generating section generates each e-mail message by using a format suitable for the communication terminal of the addressee, so that the communication terminal can read the e-mail message, and wherein the communication terminal of the addressee is a car navigation system.

This allows a user to address and send an e-mail message to an addressee with attached positional data such that the addressee can read the e-mail message at a car navigation system and set a navigational route according to the positional data in the e-mail.

The Office Action admits that Nakano does not disclose or suggest generating an e-mail message by using a format suitable for a car navigation system. The Office Action points to Obradovich as teaching this feature.

Obradovich teaches a multimedia information system for use in an automobile, where the system is capable of receiving low frequency low-power broadcasts providing

a GPS map or a local directory of certain locations. However, Obradovich does not discuss generating e-mail or generating any type of message that is directed to a particular addressee. Obradovich merely deals with receiving area-wide broadcasts.

Thus, the Applicants submit that Obradovich does not disclose or suggest at least an e-mail generating section that generates each e-mail message by using a format suitable for the communication terminal of the addressee, so that the communication terminal can read the e-mail message, and wherein the communication terminal of the addressee is a car navigation system, as recited in amended claims 20 and 21.

For at least this reason, the Applicants submit that claims 20 and 21 are allowable over the cited art.

D. Claims 22 and 23

Amended claims 22 and 23 recite in part an e-mail sending and receiving system including a destination setting section for setting one of the physical positional data attached to a received e-mail message as a destination.

This allows the addressee, who has received the e-mail message to set one of the attached positional data to be set as a destination, such as a destination for a car navigation system and set a navigational route according to the positional data in the e-mail.

Nakano teaches a user accessing a map information website and sending a message with map information. However, Nakano does not disclose or suggest a destination setting section for setting one of the physical positional data attached to a received e-mail as a destination.

For at least this reason, the Applicants submit that claims 22 and 23 are allowable over the cited art.

II. Tso in view of Nakano

In the alternative, claims 1-17, and 20-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,047,327 to Tso et al. ("Tso") in view of Nakano; and claims 18-19 as being unpatentable over Tso in view of Nakano and further in view of Obradovich.

Tso teaches a server automatically distributing electronic information to a targeted group of users, depending on information contained in the profile of the receiver. (See column 1 lines 48-50 and column 2 lines 40-43). Tso does not teach the receipt of information at a web page, which is used to attach location information to an e-mail message.

A. Claims 1, 3-5, 7-9, 11-13, 15-16, and 18-19

The Applicants submit that neither Tso nor Nakano disclose or suggest an e-mail sending and receiving system where each e-mail is written on a web page provided by a communications center, the system comprising a positional data storage section, wherein the positional data storage section includes a plurality of physical positional data registered by an addresser, as recited in amended claims 1 and 9.

As discussed above, Nakano does not disclose or suggest a positional data storage section including a plurality of physical positional data registered by an addresser.

Tso teaches a server automatically distributing electronic information to a targeted group of users, depending on information contained in the profile of the receiver. (See column 1 lines 48-50 and column 2 lines 40-43).

The Office Action cites column 4, lines 33-48 of Tso as teaching the claimed positional data storage section including a plurality of physical positional data registered by an addresser. In this section, Tso merely teaches that positional information on “users” is stored in a server. However, in Tso, the “users” are the recipients of generated mail, not the addressers and the users do not register a plurality of physical positional data.

For at least these reasons, the Applicants submit that claims 1 and 9, as amended, are allowable over the cited prior art. As claims 1 and 9 are allowable, the Applicants submit that claims 3-5, 7-8, 11-13, 15-16, and 17-19, which depend from allowable claims 1 and 9, are likewise allowable.

B. Claims 6 and 14

The Applicants submit that neither Nakano nor Tso disclose or suggest an e-mail sending and receiving system for sending and receiving e-mail between communication terminals, including a detailed data generating section for generating detailed data relating to each physical positional data attached to the e-mail message, and attaching a URL for accessing the detailed data to the e-mail message; and a positional data register section for storing the detailed data in the positional data storage section according to a request from the communication terminal of the addressee, as recited in claims 6 and 14.

As discussed above, Nakano does not disclose or suggest an e-mail sending and receiving system including at least this feature.

The Office Action cites column 6, lines 5-20 of Tso as teaching these claimed features. However, Tso merely teaches a database containing pointers associated with a fully qualified URL. The database is essentially a lookup table for determining which pointers are associated with which URL. Tso does not disclose or suggest generating detailed data relating to each physical positional data attached to the e-mail message, and attaching a URL for accessing the detailed data to the e-mail message. Additionally, Tso does not disclose or suggest a positional data register section for storing the detailed data in the positional data storage section according to a request from the communication terminal of the addressee

For at least these reasons, the Applicants submit that claims 6 and 14 are allowable over the cited art.

C. Claims 20 and 21

The Examiner admits that neither Tso nor Nakano disclose or suggest generating an e-mail message by using a format suitable for a car navigation system. The Office Action relies on Obradovich for this feature.

As discussed above, in section I(C), Obradovich does not disclose or suggest an e-mail sending and receiving system including at least a mail generating section that generates each e-mail message by using a format suitable for the communication terminal of the addressee, so that the communication terminal can read the e-mail message, and wherein the communication terminal of the addressee is a car navigation system, as recited in amended claims 20 and 21.

For at least this reason, the Applicants submit that claims 20 and 21 are allowable over the cited art.

D. Claims 22 and 23

Applicants' invention as set forth in claim 22 is directed to an e-mail sending and receiving system including a destination setting section for setting one of the physical positional data attached to a received e-mail message as a destination.

The Office Action does not address this feature, and the Applicants submit that neither Tso nor Nakano disclose or suggest at least the feature of a destination setting section for setting one of the physical positional data attached to a received e-mail message as a destination, as recited in claims 22 and 23

For at least this reason, the Applicants submit that claims 22 and 23 are allowable over the cited art.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish

obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 5-10. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

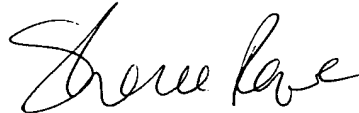
Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with

Application No.: 09/739,397
Attorney Docket No.: 107439-00027

this communication to Deposit Account No. 01-2300, referencing Attorney Docket
No. 107439-00027.

Respectfully submitted,
Arent Fox PLLC

A handwritten signature in black ink, appearing to read "Sheree Rowe". The signature is fluid and cursive, with the first name "Sheree" being more prominent than the last name "Rowe".

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